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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,956

11/07/2006

Daniel Reis

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THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314

EXAMINER

LEWIS, KIM M

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,956	Applicant(s) REIS ET AL.	
	Examiner Kim M. Lewis	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/15/08, 10/18/08, 5/10/07</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 10797278, filed 3/10/04. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is

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considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement filed 7/15/08, 10/18/07 and 5/10/07 has been received and made of record. Note the acknowledged PTO-1449 forms or substitutes therefor enclosed herewith.

Specification

4. The use of the trademark Velcro® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The disclosure is objected to because of the following informalities: On page 9, the applicant's references and describes the embodiment of Fig. 4, however, the description is intended for Fig. 5. And on page 9, in the third full paragraph, the reference to Fig. 5 relates to Fig. 4.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claims 10 (soldering means), 14 (electrical pump) and 15 (canister) lack antecedent basis in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claim 3, the use of the Trademark Velcro in the claim renders the claim indefinite since the trademark is used in the claim as a limitation to identify or describe a particular material or product.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 6, 12 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,957,872 ("Flick").

As regards claim 1-3, 6, 12 and 16-21, Flick discloses a heel care device and method that anticipates applicant's claimed invention. More specifically, Flick discloses a splint for immobilizing and supporting a limb or other body parts of a human, wherein said splint is made of flexible material (col. 3, lines 1-5) for covering body parts and articulations from at least three sides and where said splint includes: a. inflatable tubes

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(48) interconnected by non-inflatable parts for achieving variable degrees of support, stiffness and restriction of movement; b. ventilation holes (27) for skin ventilation, contained in the non-inflatable parts; c. at least one gas pressure source (col. 3, lines 43-46) device connected to said splint; d. at least one adjustable strap (15, 16, 52, 53) for connecting splint edges; wherein the inflated structure of the splint fits the structure and anatomical shape of the appropriate body part for the purpose of stabilizing and providing support to the patient's body part and its articulations in varying degrees of rigidity and in particular positions.

As can be seen in Fig. 7, part of the limb remains uncovered. Also, the adjustable straps are constructed from Velcro, the splints wrap around the leg, foot and heel of a patient. It is clear from the disclosure of Flick that movement, rigidity and stabilization of the limb articulation can be controlled by the degree of air pressure in the splint. In the inflated state, the splint takes the shape of the body part, and tightening or loosening of the straps can control tightness of the splint. As can be seen in Fig. 10, the splint includes a suspension strap (182) in that it suspends the foot forward.

Furthermore, pressure in the splint is controlled by a valve (col. 3, lines 44), the adjustable straps are capable of being detached, and the degree of rigidity of the splint is capable of enabling partial movement of the joint.

11. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0042585 A1 ("Kloecker").

As regards claim 8, Kloecker discloses an inflatable splint assembly made of flexible material (1, 2) for covering body parts from at least three sides, wherein the

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splint includes, a. inflation tubes (4) as shown in Fig. 4, interconnected by non-inflatable parts (seams 11 and edges 14), b. ventilation holes (11) in the non-inflated parts; c. a gas pressure source; d. at least one adjustable strap (18, 22) for connecting splint edges; wherein said inflated splints fits the structure and shape of the body part and supports the part in varying degrees of rigidity. Kloecker discloses that the splint can be configured to wrap about the shoulder, arm and palm (Fig. 2a).

Claim Rejections - 35 USC § 103

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 4, 5, 9 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 200310176825 A1 ("Yavnai") in view of Flick.

As regards claims 4, 5, 9 and 13-15, Yavnai discloses an inflatable splint assembly made of flexible material (102, 104) for covering body part from at least three sides, where said splint includes: a. inflatable tubes (124, Fig. 3c, for example) interconnected by non-inflatable parts (seams 106); c. a gas pressure source [0090]; d. at least one adjustable strap (see Figure 4, for example) for connecting splint edges; wherein said inflated splints fits the structure and shape of the body part and supports the part in varying degrees of rigidity. Yavnai discloses that the splint can be configured to wrap about the torso and rib cage (Fig. 13a) or the neck (Fig. 6) to support various regions of the body. Yavnai specifies that a mechanical pump, an electrical pump or a

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pressure canister can provide the inflation gas [0090], as selected per the convenience of the user. Yavnai fails to disclose ventilation holes.

Flick, however, discloses an inflatable splint assembly comprising ventilation holes to allow airflow to the limb being treated. It would have been obvious to one having ordinary skill in the art to have provided the splint disclosed by Yavnai, wherein the splint is provided with ventilation holes, as taught by Flick, to provide airflow to the limb being treated.

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flick in view of U.S. Patent Number 4,157,713("Clarey").

As regards claim 7, Flick discloses the previously described leg splint assembly. Flick does not specify that the splint extend up the thigh. Clarey discloses a leg splint assembly, wherein the inflatable splint extends from the foot to the thigh, to support the entirety of the user's leg.

It would have been obvious to one having ordinary skill in the art to have provided the splint disclosed by Flick, wherein the leg splint extends to the upper thigh, as taught by Clarey, to provide complete support for the entire leg.

17. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick in view of U.S. Patent Application Publication Number 200310191420 A1 ("Kuiper et al.")

Flick discloses the previously described splint assembly. Flick does not specify that the splint be made of nylon. Kuiper et al., however, discloses a splint assembly that is made of two nylon layers (22, 24) coated with polyurethane, to be fluid tight. Kuiper et

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al. also disclose that the edges of the layers are "soldered" together (*i.e.*, RF, heat ultrasonically welded), in as far as the "soldering" process has been defined.

It would have been obvious to one having ordinary skill in the art to involved have provided the splint disclosed by Flick, wherein the two splint layers are nylon coated with polyurethane and soldered together, as taught by Kuiper et al., to have provided a fluid tight splint.

18. Claims 13-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Flick in view Yavnai

19. As regards claims 13-15, Flick discloses the previously describes inflatable splint assembly. Flick discloses that inflation gas is provided to the splint via a nozzle (45) but does not specify the type of pressure source that delivers the gas.

Yavnai disclose an inflatable splint assembly that is inflated by a pressure source. Yavnai specifies that a mechanical pump, an electrical pump or a pressure canister can provide the inflation gas [0090], as selected per the convenience of the user.

It would have been obvious to one having ordinary skill in the art to have provided the splint disclosed by Flick, wherein the inflation gas is provided by a mechanical pump, an electrical pump or a pressure canister, as taught by Yavnai, per the convenience of the user.

20. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flick in view of U.S. Patent Application Publication Number 2002/0143280 A1 ("Souney et al").

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As regards claim 22, Flick discloses the previously described inflatable splint assembly for a lower leg. Flick does not specify a loop at the edge of the splint. Souney et al., however, discloses a splint for a lower leg, wherein the edge of the splint comprises a loop (34), to enable traction application to the patient's leg.

It would have been obvious to one having ordinary skill in the art to have provided the lower leg splint disclosed by Flick, wherein the splint includes a loop at its edge, as taught by Souney et al., to apply traction to the user's leg.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Wednesday to Friday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kim M. Lewis/
Primary Examiner
Art Unit 3772

kml
9/30/08